



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

10

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,106	07/23/2003	Timothy Jon Haataja	2316.1196USD1	8972
7590	05/26/2005		EXAMINER	
Karen A. Fitzsimmons MERCHANT & GOULD P.C. P.O. Box 2903 Minneapolis, MN 55402-0903			JIMENEZ, MARC QUEMUEL	
			ART UNIT	PAPER NUMBER
			3726	

DATE MAILED: 05/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/626,106	HAATAJA ET AL.	
Examiner	Art Unit		
Marc Jimenez	3726		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 09 May 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-9 and 20-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-9 and 20-26 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 09 May 2005 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>05092005</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. **Claims 1-9 and 20-26** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1-9 require that first and second U-shaped end members being spaced apart “a fixed distance”. Applicant argues that “fixed distance” means that the troughs are not moveable (see page 8, lines 5-6 of applicant’s argument filed on 5/9/05). However, there is no support in the original disclosure that the end members have to be “fixed”. In figure 1 of applicant’s drawings, the end members **18 and 16** are shown connected to the telescoping trough **12**. However, the original disclosure is silent as to what the end members are connected to on the opposite sides of each of the end members **18 and 16**. The original disclosure does not specifically recite, for example, that the end member **16** is fixed. The original disclosure does not specifically state that the end member **16** could be connected to another telescoping trough or not. Therefore the limitation “fixed” added to the claims is new matter.

Claims 20-26 require that each of the cable trough members have “immovable ends”.

However, there is no support in the original disclosure that the cable trough members **18** and **16** shown in applicant's drawings have immovable ends. The cable trough members could be moved either by destructive means or by detaching each of the respective troughs **18** and **16** from their connections opposite of the telescoping troughs **12** and then moved. Even if each of the troughs **18** and **16** were welded to a wall, they would still be movable by destroying the welded connection. As noted above, the original disclosure is not specific as to how the trough members **18** and **16** are connected in the ends opposite the telescoping trough **12**. Therefore, the "immovable ends" limitation is new matter. The original disclosure is not specifically limited to require that the trough ends are "fixed" or "immovable".

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1-6, 8, 9, 20-23, and 26** are rejected under 35 U.S.C. 102(b) as being anticipated by Zetena (US 5,316,244).

Regarding claims 1-4, Zetena teaches a method of assembling a cable routing system comprising the steps of (see attached marked up sketch of figure 19 of Zetena provided by applicant in the response filed 5/9/05): providing first **15B** and second **115** spaced-apart U-shaped end members, the end members being spaced apart a fixed distance; providing a

telescoping U-shaped trough with first **15A** and second **5A** slideable trough sections positioned between the first **15B** and second **115** end members; connecting the first **5A** and second **15A** trough sections to the respective first **15B** and second **115** end members, wherein the first **5A** and second **15A** trough sections remain freely slideable upon disconnecting at least one of the first **5A** and second **15A** trough sections from the respective first **15B** and second **115** end members.

Regarding claim 5, the first and second slideable trough sections have substantially the same coupling profile (U-shaped).

Regarding claim 6, the trough sections **21,11** are slid able to fit between the first **109** and second end **21 or 115**.

Regarding claim 8, as shown in figure 6, the tab **28** creates a “slot tab” connection which stops further sliding movement.

Regarding claim 9, the retractable cable trough **21,11** allows the cable trough to be positioned between first **109** and second **21 or 115** end members and expanding the telescoping cable trough **21,11** to connect the first **21** and second **11** sections to the first **109** and second **21 or 115** end members.

Regarding claims 20-23 and 26, Zetena is considered to meet the “immovable ends” limitation because the trough member **15B** is locked in place by locking clips **25** which make the trough member immovable.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 7, 24, and 25** are rejected under 35 U.S.C. 103(a) as being unpatentable over Zetena in view of Merckle (US 3,351,699).

Zetena teaches the invention cited with the exception of the flanges of the second trough section having slots.

Merckle teaches in figure 8, flanges of a slideable trough having slots **30**.

Therefore, it would have been obvious to a person of ordinary skill in the art, at the time of the invention, to have provided the invention of Zetena with slots in the flanges of the second trough, in order to provide easier disassembly of the troughs where the inner trough could be removed from above the outer trough by pulling the inner trough upwards (see figure 12 of Merckle where the inner trough **30** could be separated from the outer trough **36** more easily). Whereas in Zetena, the troughs have to be telescopically removed or assembled.

Response to Arguments

5. Applicant's arguments filed 5/9/05 have been fully considered but they are not persuasive.

6. Applicant argues that Zetena does not teach that the trough sections **15,115** are at a "fixed" distance. It is noted however, that the trough end section **15** is connected to another trough section **109** by locking clips **25** which hold the end section **15** from moving (col. 3, lines

Art Unit: 3726

26-28). Similarly, the end section **115** is fixed at a horizontal distance (looking into figure 19) with respect to the trough member **15** which is fixed by the locking clips **25**.

7. Applicant's argument with respect to "immovable" limitation is noted. However, as noted above, this limitation is considered new matter. Also, applicant has not specifically pointed out where support for this limitation could be found in the original disclosure.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Interviews After Final

9. Applicant note that an interview after a final rejection will not be granted unless the intended purpose and content of the interview is presented briefly, in writing (the agenda of the

Art Unit: 3726

interview must be in writing) to clarify issues for appeal requiring only nominal further consideration. Interviews merely to restate arguments of record or to discuss new limitations will be denied. See MPEP 714.13 and 713.09.

Contact Information

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Jimenez whose telephone number (571) 272-4530. The examiner can normally be reached on Monday-Friday between 5:30 a.m.-2:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJ
May 20, 2005

Marc Jimenez
MARC JIMENEZ
PRIMARY EXAMINER
5/20/05